




<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional)  102965-010100						
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]  on _____  Signature _____  Typed or printed name _____		<table border="1" style="width: 100%; border-collapse: collapse;"> <tr> <td style="padding: 5px;">Application Number  10/599,623</td> <td style="padding: 5px;">Filed  October 3, 2006</td> </tr> <tr> <td colspan="2" style="padding: 5px;">First Named Inventor  John Anthony Downes</td> </tr> <tr> <td style="padding: 5px;">Art Unit  3618</td> <td style="padding: 5px;">Examiner  Brian L. Swenson</td> </tr> </table>	Application Number  10/599,623	Filed  October 3, 2006	First Named Inventor  John Anthony Downes		Art Unit  3618	Examiner  Brian L. Swenson
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<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s).          Note: No more than five (5) pages may be provided.</p>								
<table style="width: 100%;"> <tr> <td style="width: 50%; vertical-align: top;"> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest.            See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.            (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. 24075            Registration number _____</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34.            Registration number if acting under 37 CFR 1.34 _____</p> </td> <td style="width: 50%; vertical-align: top; text-align: center;">             _____            Louis J. Bovasso            _____            Typed or printed name             (310) 586-7729            _____            Telephone number             January 13, 2011            _____            Date         </td> </tr> </table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.          Submit multiple forms if more than one signature is required, see below*.</p>			<p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest.            See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.            (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. 24075            Registration number _____</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34.            Registration number if acting under 37 CFR 1.34 _____</p>	 _____ Louis J. Bovasso _____ Typed or printed name  (310) 586-7729 _____ Telephone number  January 13, 2011 _____ Date				
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<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.								

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant:	John Anthony DOWNES	Examiner:	Brian L. Swenson
Serial No.:	10/599,623	Group Art Unit:	3618
Filed:	October 3, 2006	Docket No.	102965-010100
Customer No.:	33717	Confirmation No.:	1812
Title:	SPRAY PREVENTION DEVICE		

**CERTIFICATE OF TRANSMISSION**

I hereby certify that this document is being transmitted electronically to the United States Patent and Trademark Office via the EFS Web e-Filing system on January 13, 2011.

  
Name: Rosemary D. Payton

**REASONS FOR REQUEST FOR PANEL REVIEW**

MAIL STOP: AMENDMENT  
Commissioner for Patents  
Post Office Box 1450  
Alexandria, Virginia 22313-1450

Sir/Madam:

Pre-appeal brief conference review is appropriate when there are clear errors in the Examiner's review and/or the Examiner has omitted one or more essential elements needed for a prima facie rejection. Applicants believe that at least one of the conditions is present here.

Claims 1 to 4, 6 to 10 and 12 to 16 are pending in the application. Claim 13 is withdrawn. Claims 1 and 14 to 16 are the only independent claims in this application. The Examiner rejected claims 1 and 14 to 16 as unpatentable over Downes (UK Pat. No. 2,229,689), further in view of Metcalf (US Pat. No. 5,257,822), Jain et al (US Pat. No. 6, 799,782), Morin (US Pat. No. 4,921,276), Bajorek et al (US Pat. No. 5,564,750), and Sheppard (US Pub. No. 2002/0109347). Thus, 6 references have been applied against independent claims 1 and 14 to 16.

The invention, as claimed in independent claim 1, is directed to a device for preventing spray from emerging from a wheel of a vehicle. The device comprises a planar linearly and vertically extending panel mounted vertically behind a vehicle wheel and spaced therefrom for receiving on a first side water released by the wheel as it rotates. The panel includes at least one passage which leads from the first side to a rear second side of the panel, the at least one passage being other than normal to the plane of the panel, and at least one vertically extending water-collecting pocket along a side of the at least one passage. Thus, in use, air and water entering the at least one passage are separated so that air passes through the at least one passage and mixes with ambient air on a second side of the panel, and water collects in the at least one water-collecting pocket.

It is not certain where the examiner is going with 6 references. For example, why is the citation of Jain necessary if Metcalf is a good reference?

The device of Downes, as a whole, is not mounted behind the wheel. The forward air ingress mesh 10 is mounted forward and above the wheel and the forward part of the vanes 4, 5 are above the wheel rather than behind the wheel. As for Metcalf, all that Metcalf teaches is a planar, linearly and vertically extending panel mounted behind a wheel but it isn't obvious to ignore all the other features of Metcalf. The "known technique of the spray suppression technique as disclosed by the structure of Downes" in the '689 patent is a completely new wheelarch arrangement having different air/spray flow characteristics and it is the complete wheelarch that constitutes the 'new technique', not just random parts selected with hindsight.

The device of Jain is not mounted vertically behind a wheel but curves around the lower margin of the wheelarch. Figures 2 and 5, of Jain, for example, show that the device is not planar or linearly and vertically extending.

The arrangement of Sheppard actually specifies an enclosure comprising side walls 12, 14 in conjunction with a top wall and a rear panel. With all of the additional prior art arrangements just cited, the examiner is taking an isolated feature and ignoring all of the remaining, supposedly essential features of the prior art, as discussed above with respect to Metcalf. The examiner's arguments are therefore flawed for at least the same reasons.

Claims 2 to 4, 6 to 10 and 12 are dependent from claim 1 and likewise patentable. Claim 14 is a method claim similar to claim 1 and claims 15 and 16 are also similar to claim 1 and patentable for the same reasons as set forth above.

Further, with regard to Downes as applied against dependent claim 2, in the Downes arrangement, the vanes 4, 5 are clearly curved around the rear top quarter of a wheel and figure 3 clearly discloses two rows of vanes 4, 5 having a mesh 8 disposed therebetween. The mesh 8 is provided for a reason in Downes, small droplets of water form on the mesh and combine to form larger droplets which carry over to the second set of vanes 5.

With further regard to the rejection of dependent claim 9, in Downes, the pockets 7 curve around the wheel as shown in figure 1 and so the pockets do not run substantially vertically along a baffle as stated in claim 9.

With further regard to the rejection of method claim 14, Downes specifically teaches away from simple flaps by disclosing a completely new wheelarch arrangement. At the time of the Downes invention, various after-market flaps would have been available but Downes chose to completely re-design the wheelarch itself in an attempt to reduce spray. Downes does not teach or suggest the use of a linear and vertically extending planar panel but provides a new wheelarch that extends 180° around the top half of the wheel. The total re-design of Downes was intended to prevent spray formation without the need for extra flaps.

As for independent claim 15, Downes in the '689 patent discloses a novel complete wheelarch and therefore teaches away from anything associated with standard wheelarches. The examiner has cited a number of panel-like flaps which could be attached to a wheelarch. It is possible that these could be applied to the original Downes wheelarch in the '689 patent such that they could operate in conjunction with one another. There is no suggestion in any of the prior art that the technology of wheelarches is interchangeable with the technology of after-market flaps. The actual flaps cited by the examiner work in a completely different way to Downes ('689 patent) and it is only with hindsight that the skilled person would seek to modify Metcalf by ignoring all of the constructional features considered essential in Metcalf and replacing them with selected parts of Downes ('689 patent) taken out of context from the whole

construction of Downes ('689 patent). The forward air ingress mesh was considered essential to Downes ('689 patent) in order to create a suitable airflow for the curved vanes to operate. This mesh is of course not present in the current claimed method.

As the Court said in *KSR Int'l Co. v Teleflex Inc., et al.*, 550 U.S. 398, (2007), in discussing hindsight. "The Court of Appeals, finally, drew the wrong conclusion from the risk of courts and patent examiners falling prey to hindsight bias. A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning.

In his closing arguments in the final rejection mailed 10/14/10, the examiner seems to be focusing too much on the adaptability of the present invention to known wheel arrangements. It is known that there were a number of flaps available for trying to reduce spray. The main point is that Downes '689 patent discloses only a wheelarch, the wheelarch incorporating a number of features which in combination were intended to reduce spray. For example, the forward air ingress mesh 10 changes the air flow characteristics particularly for the curved vanes around the upper rear quarter of the wheel. Downes '689 patent should therefore be viewed as a wheelarch package rather than a series of isolated features which individually reduce spray.

Metcalf teaches a new type of wheelflap for simple addition to an existing wheel assembly. If the user of the Downes wheelarch in the Downes '689 patent wished to improve performance, then the obvious thing to do would be to add a Metcalf wheelflap. That would be the obvious combination of the two disclosures.

Tests have showed that the wheelarch of Downes was not effective at reducing spray. As stated previously, it is our view that it is only hindsight which can enable a skilled person to change an ineffective wheelarch designed to create a specific air flow within the wheelarch (by virtue of the forward, curved air ingress mesh and the channels in the rear, curved vanes) and convert it into an effective vertical panel for mounting behind any known wheel arrangement.

It is submitted that it is not obvious to apply the spray suppression technique of Downes into a panel like Metcalf. The whole reason for Downes was to create a spray preventing wheelarch. The skilled person would not seek to combine these references because Downes

teaches away from the bolt-on panel approach by modifying the whole flow of water/air/spray through the wheelarch. An essential feature taught by Downes is the forward air ingress mesh which extends around the front of the vehicle wheel. It is only with hindsight that a combination of two prior art documents can simply omit essential features from one or both documents.

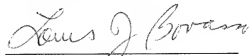
In conclusion, the examiner is taking the Downes disclosure completely out of context by (i) omitting essential features such as the forward mesh then (ii) removing the curved vanes out of their intended location as part of a vehicle wheelarch. (iii) changing the shape of the vanes from their original curved design to a planar vertical panel and (iv) transplanting them to a location for which they were never intended, just because various prior art documents show a vertical panel attached to a wheelarch. How can this not be with hindsight??

Thus, claim 1, and independent claims 14 to 16, are clearly patentable over the 6 references cited. Claims 2 to 4, 6 to 10 and 12, dependent from claim 5, are also clearly patentable.

It is respectfully submitted that the Examiner's rejection in the Final Office Action is clearly erroneous and that this application is in condition for allowance.

The Director is authorized to charge fees for filing of a Notice of Appeal as well as any additional fee(s) or any underpayment of fee(s), or to credit any overpayments to Deposit Account Number 50-2638. Please ensure that Attorney Docket Number 102965-010100 is referred to when charging any payments or credits for this case.

Respectfully submitted,

  
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Louis J. Bovasso

Date: January 13, 2011

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